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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/697,104

10/31/2003

Eisaku Tozaka

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05/31/2006

BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

AHMAD, NASSER

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,104

Applicant(s)

TOZAKA ET AL.

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-6,8,9,13-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 7,10-12 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejection Withdrawn

1. Claims 1-3 rejected under 35 U.S.C. 102(b) as being anticipated by Ellis(1664601) made in the Office Action of July 26, 2005 has been withdrawn in view of the amendment filed on March 15, 2006.
2. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Mullen (6749861) made in the Office Action of July 26, 2005 has been withdrawn in view of the amendment.
3. Claims 9-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement made in the last Office action of December 30, 2005 has been withdrawn in view of the amendment.
4. Claims 8-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention made in the last Office action of December 30, 2005 has been withdrawn in view of the amendment.

Allowability Withdrawn

5. Claims 4-7 are objected to as being dependent upon a rejected base claim, but would be allowable made in the last Office Action has been withdrawn in view of the newly discovered prior art.

Response to Arguments

6. Applicant's arguments with respect to claims 2 and 4-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by The English Abstract of Japanese:5-117124.

The English Abstract relates to an adhesive solution comprising dispersed powder of wood containing hinokitiol. It is well known in the art that adhesive solution include a resin base. Further, the fine powder of wood is interpreted by the examiner to be microcapsule of porous particle because the hinokitiol is discharged from said porous particle.

9. Claims 2, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by The English Abstract of Japanese:9-163909.

The English Abstract relates to an adhesive composition comprising a resin base, hinokitiol and cellulose, which is known to be a thickener or thickening agent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 2, 4-6, 8-9, 14-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Tozaka (2005/0040227)

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Tozaka'227 relates to an adhesive for wood comprising a s amain component a resin base, which is mixed with a microcapsule comprising a septal wall made of a plurality of porous paricle and including hinokitiol (abstract). The porpous particle can be, diatomite, zeolite, pumicite, or mixtures thereof (paragraph-[0009]). The presence of the microcapsule is interpreted to be thickening agent.

Figure-11 shows that the panels are adjacent to each other are overlapped in layers (claim 9).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 6, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over The English Abstract of Japanese: 408174515.

The English Abstract relates to a woody material comprising a decorated laminated glued wood. By the word laminated, it is understood by the examiner that the woody material is a laminate of a plurality of woody single panels and adhesively bonded together forming the laminated glued wood. The Abstract further release to a decorated sheet that is bonded to the front face of the laminate by using an adhesive containing hinokitiol. However, The English Abstract fails to teach that the adhesive between the woody panels is a hinokitiol containing adhesive composition. It would have been obvious to one having ordinary skill in the art to utilize the adhesive to contain hinokitiol for providing protection to the woody laminate of the English Abstract..

Allowable Subject Matter

13. Claims 7, 10-12 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art uncovered so far fails to teach that the laminated woody panels are arranged such that the fibers in each panel are oriented at right angle or parallel to the

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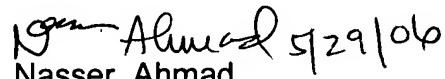
adjacent panel, or that sepiolite as the mineral thickening agent for the adhesive composition.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
May 29, 2006.